

**REMARKS**

In the Office Action, claims 1, 2, 12 and 13 remain rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,123,003 to Noda et al. (hereinafter “Noda”). Claims 3 and 14 remain rejected under 35 U.S.C. § 103(a) as being unpatentable over Noda as applied to claims 1 and 12, and further in view of U.S. Patent No. 6,545,959 to Iida (hereinafter “Iida”). Claims 9 and 18 remain rejected under 35 U.S.C. § 103(a) as being unpatentable over Noda as applied to claims 1 and 12, and further in view of U.S. Patent No. 5,959,953 to Alon (hereinafter “Alon”). Claims 10, 11, 19 and 20 remain rejected under 35 U.S.C. § 103(a) as being unpatentable over Noda as applied to claims 1 and 12, and further in view of U.S. Patent No. 5,404,344 to Imada et al. (hereinafter “Imada”). Claims 4-8 and 15-17, while objected to as being dependent upon a rejected base claim, would be allowable if rewritten in independent form. These rejections and objections are respectfully traversed for at least the following reasons.

In response to the detailed arguments submitted by Applicants in the previous response filed on October 4, 2004, the Final Office Action asserts that “Noda does not ‘teach away’ from using the  $\pm$  second order diffraction lights. Column 4, lines 1-2 clearly state that ‘light spots  $5m$  and  $5n$  due to the  $\pm$  2nd-order diffraction lights are also produced.’” The Final Office Action goes on to assert that the “statement on column 4, lines 3-5 that ‘since [the  $\pm$  2nd-order diffraction lights] have no particular relation with the present invention, the explanation thereof will be omitted” does not prove that Noda teaches away from using the  $\pm$  second order diffraction lights, as argued by applicants. Claim 1 only requires the claimed grating element to create zero,  $\pm$  first and  $\pm$  second order diffraction lights...”

Applicants continue to traverse the rejections of at least independent claims 1 and 12 without amending the claims for at least the following reasons. For example, each of independent claims 1 and 12 directly recite that  $\pm$  second order diffraction light is specifically used within the recited combinations. The Examiner concedes to this fact at least at page 7, lines 9-10 of the Final Office Action stating that “[c]laim 1 only requires the claimed grating element to create zero,  $\pm$  first and  $\pm$  second order diffraction lights (emphasis added)...” Even though col. 4, lines 1-2 of Noda states that “light spots 5m and 5n due to the  $\pm$  2nd-order diffraction lights are also produced...,” it is particularly important to note that this sentence in Noda goes on to explain that “... but since these have no particular relation with the present invention, the explanation thereof will be omitted (emphasis added).” Accordingly, even though Noda states that  $\pm$  second order diffraction lights are produced by its disclosed arrangement, there is no associated teaching of actually using the  $\pm$  second order diffraction lights in Noda. Instead, Noda explicitly states that these diffraction lights have “no particular relation with the present invention” and that any associated explanation of such diffraction lights will thus “be omitted.”

Accordingly, Applicants respectfully submit that it is clear that Noda cannot be relied upon for a disclosure of utilizing  $\pm$  second order diffraction lights within an optical pickup device to any extent. Even further, the specific implementation of  $\pm$  second order diffraction lights, as recited in combination with the remaining features within each of independent claims 1 and 12 of the instant application are certainly not met by Noda.

Applicants respectfully submit that Noda does not teach use of  $\pm$  second order diffracted light within an optical pickup device or apparatus combination, as specifically recited in independent claims 1 and 12, respectively. While Noda incidentally teaches the generation of  $\pm$  second order diffracted light, there is no teaching or suggestion in Noda of actually using the  $\pm$

second order diffracted light within an optical pickup device or apparatus combination, as recited in the claims of the instant application.

With regard to the assertion in the Final Office Action that “[c]laim 1 only requires the claimed grating element to create zero,  $\pm$  first and  $\pm$  second order diffraction lights...,” Applicants respectfully submit that independent claim 1 recites an optical detector for using the  $\pm$  second order diffracted light in a specific way. For example, the last three lines of claim 1 explicitly indicate “ $\pm$  second order diffracted light, to produce output signals used to create an error signal.” Thus, Applicants respectfully submit that independent claim 1 clearly recites that the  $\pm$  second order diffracted light is used to generate the error signal. On the other hand, Noda does not teach any element which specifically uses the  $\pm$  second order diffracted light to generate an error signal, or any other type of signal for that matter. Claim 12 also includes very specific recitations with regard to the use of  $\pm$  second order diffracted light within its apparatus combination recitations.

While col. 3, lines 3-5 of Noda discloses the generation of  $\pm$  second order diffracted light, Applicants respectfully submit that there is no teaching or suggestion of utilizing this light in the manners recited in each of independent claims 1 and 12 of the instant application. Even further, Noda explicitly states that  $\pm$  second order diffracted lights have “no particular relation with the present invention” and that any associated explanation of such diffraction lights will thus “be omitted.” Accordingly, it is clear that Noda can not be relied upon for either: 1) any teaching of the use of  $\pm$  second order diffracted lights, and 2) more particularly, for the use of  $\pm$  second order diffracted lights in the specific manner recited in each of independent claims 1 and 12 of the instant application, as discussed above. If the Examiner intends to maintain these rejections in the next Office Communication, he is respectfully requested to point out where in Noda the

specific features of using  $\pm$  second order diffraction lights in the manners recited in independent claims 1 and 12 are disclosed.

Applicants respectfully assert that the rejections under 35 U.S.C. §§ 102(b) and 103(a) should be withdrawn because Noda does not teach or suggest each feature of independent claims 1 and 12. As pointed out in MPEP § 2131, "[t]o anticipate a claim, the reference must teach every element of the claim." Thus, "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Verdegaal Bros. v. Union Oil Co. Of California, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987)."

Moreover, with regard to the rejection under 35 U.S.C. § 103(a), the applied secondary references to Iida, Alon and Imada fail to cure the deficiencies discussed above with regard to Noda. MPEP § 2143.03 instructs that "[t]o establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 409 F.2d 981, 180 USPQ 580 (CCPA 1974)." Accordingly, Applicants respectfully assert that dependent claims 2-11 and 13-20 are allowable at least because of the dependence from their respective independent claims and the reasons set forth above.

The Examiner is thanked for the indication that claims 4-8 and 15-17, while objected to as being dependent upon a rejected base claim, include allowable subject matter. However, Applicants respectfully request that the objection to these claims be withdrawn at least for the foregoing reasons.

**CONCLUSION**

In view of the foregoing remarks, Applicants respectfully request reconsideration of this application, withdrawal of all rejections, and the timely allowance of all pending claims 1-8.

Should the Examiner feel that there are any issues outstanding after consideration of this response, the Examiner is invited to contact Applicants' undersigned representative to expedite the prosecution.


**EXCEPT** for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. §§ 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account 50-0310. This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with 37 C.F.R. § 1.136(a)(3).

Respectfully submitted,

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